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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,745	12/30/2003	Jonathan Leblang	MIPS.100A	2677
20995	7590	10/30/2008	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			JOSEPH, TONYA S	
2040 MAIN STREET				
FOURTEENTH FLOOR			ART UNIT	PAPER NUMBER
IRVINE, CA 92614			3628	
			NOTIFICATION DATE	DELIVERY MODE
			10/30/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/748,745	LEBLANG, JONATHAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	TONYA JOSEPH	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13 and 50-62 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 and 50-62 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____ .                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/01/2004; 03/01/2004; 07/16/2008</u> .                      | 6) <input type="checkbox"/> Other: ____ .                         |



**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 50-62, drawn to an article processing system, classified in class 705, subclass 1.
  - II. Claims 63-78, drawn to an order manipulation tool, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination II has separate utility such as an order manipulation tool. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election

shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Sean Parmenter on 10/23/2008 a provisional election was made with traverse to prosecute invention I, Claims 1-13 and 50-62. Affirmation of this election must be made by applicant in replying to this Office action. Claims 63-78 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Objections***

6. Claim 50 is objected to because of the following informalities:
7. Applicant's preamble recites, "an apparatus stored on a computer readable medium". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 6, 9-10, 12-13, 50, 52, 55, 58-59 and 61-62 are rejected under 35 U.S.C. 102(b) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1.

10. As per Claims 1 and 50, Knorr teaches a database that stores article identification information and article location information for a plurality of articles (see para. 17 and 22); a first module that determines at least a shipment date when a pending user order is to be shipped, wherein the pending order was placed via a computer network during a first network session (see para. 50); a second module that, based at least in part on information retrieved from the database, identifies at least a first article that can be added to the pending order within a first amount of time without delaying the shipment date of the pending order (see para. 65); and a third module that

causes a notification to be presented to the user, wherein the notification indicates that the user can add at least the first article to the pending order without delaying the pending order shipment (see para. 65, Examiner is interpreting interacting with the customer as notifications).

11. As per Claims 3 and 52, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the third module causes the notification to be presented to the user at least partly in response to determining that the user is accessing the computer network (see para. 42).

12. As per Claims 6 and 55 Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the notification includes an order incentive offer (see para. 42).

13. As per Claims 9 and 58, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on at least one article type in the pending order (see para. 65, Examiner is interpreting cross-selling as being based on an article type of a pending order).

14. As per Claims 10 and 59, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on user history order information retrieved from the database (see para. 65).

15. As per Claim 12 and 61, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the first article is identified based in part on user preference information retrieved from the database (see para. 42 and 65).

16. As per Claim 13 and 62, Knorr teaches the system of claim 1 as described above. Knorr further teaches wherein the notification is provided to the user at least-one after the pending order was placed (see para. 42 and 65).

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 2 and 51 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Marston et al. U.S. Pre-Grant Publication No. 2004/0260710 A1.

19. As per Claims 2 and 51, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Martson wherein the notification is an icon displayed via a toolbar on a user terminal (see para. 32). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Marston to alert a user of a change in a system.

20. Claims 4 and 53 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Shinohara et al. U.S. Pre-Grant Publication No. 2003/0097311 A1.

21. As per Claim 4 and 53, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Shinohara wherein the notification

is provided via an email transmitted to a user email address (see para. 187). It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Shinohara to receive the status of an ordered item.

22. Claims 5, 8, 11, 54, 57 and 60 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Official Notice.

23. As per Claims 5 and 54, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by wherein the notification includes a link, wherein if the user activates the link after the first amount of time, the user is provided a message indicating that the first amount time to add articles to the pending order has expired. Official Notice is taken that a notification including a link and providing a notification to a user that a link has expired is old and well known. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Official Notice to provide adequate order and offer information to a user.

24. As per Claims 8 and 57, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach wherein the location information is used by the second module to determine how long it would take to transport the first article from a storage area to a packing area. Official Notice is taken that using location information to determine transport time to an area is old and well known. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of invention to modify the

system of Knorr to include the teachings of Official Notice to calculate an estimated shipment date.

25. As per Claims 11 and 60, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach, wherein the first article is identified based in part on the quantity of the first article in inventory in an order fulfillment center from which at least one article in the pending order is to be shipped. Official Notice is taken that identifying and article based on a quantity available in a shipping center is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Official Notice to up-sell overstocked items.

26. Claims 7 and 56 are rejected under 35 U.S.C. 103(a) as being anticipated by Knorr et al. U.S. Pre-Grant Publication No. 2002/0077929 A1 in view of Silverbrook et al. U.S. Pre-Grant Publication No. 2003/0130903.

27. As per Claims 7 and 56, Knorr teaches the system of claim 1 as described above. Knorr does not explicitly teach the limitation taught by Silverbrook a fourth module, that, during a second network session, provides that user with an interface via which the user can add the at least first article to the pending order (see para. 558). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Knorr to include the teachings of Silverbrook to allow a user the flexibility to alter an order.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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